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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZACHARIAH J. REID,
LUCIA T. AKERS,
ALAN M. BRAATEN,
JAMES RONALD CLARK,
JOHN F. HUNT,
DANIEL R. SCHUESSLER, and
AUDREY J. DITTMAN-HALL,

Appeal 2009-001788
Application 09/862,626
Technology Center 3600

Decided: September 23, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Zachariah J. Reid, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-76. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A contract generation and administration system comprising: a single contract database comprising data obtained from multiple contract documents, said data organized into fields comprising: draft contract status, contract identifier, contract type, effective date, and expiration date; and a field comprising obligation type, owner, status or due date; said system capable of generating reports based on said database, said reports obtainable through search of said fields; and said database being selectively accessible by a plurality of users.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Albazz US 2002/0042782 A1 Apr. 11, 2002

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed Jun. 11, 2007) and Reply Brief ("Reply Br.", filed Mar. 28, 2008), and the Examiner's Answer ("Answer," mailed Jan. 28, 2008).

The Examiner takes Official Notice that “databases are old and well known” (Final Rejection 4 and Answer 5). (The Examiner cited US 7,016,859 as evidence in support of thereof. *See* Final Rejection 2 and Answer 5).

The following rejection is before us for review:

1. Claims 1-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over Albazz and Official Notice that “databases are old and well known” (Answer 5).

ISSUES

Have the Appellants shown error in the rejection of claims 1-76?

FINDINGS OF FACT

We rely on the Examiner’s factual findings (*see* Answer 5-6 and Final Rejection 3-4)

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill

in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

Claims 1-11

The Appellants argued claims 1-11 as a group (App. Br. 12 and Reply Br. 4). We select claim 1 as the representative claim for this group, and the remaining claims 2-11 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner took Official Notice that databases are well known (Answer 5). That was an essential element of the Examiner’s *prima facie* case of obviousness because the claims are directed to a system comprising a database and Albazz does not appear to disclose one. It was therefore essential for the Examiner to fill the missing disclosure in Albazz in order to find the claimed system would have been obvious to one of ordinary skill in the art. The Examiner did this by relying on the conventionality of databases. Accordingly, the claims were not rejected over Albazz alone but over Albazz and that “databases are old and well known” (Answer 5).

“The question in a [§] 103 case is what the references would [c]ollectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 56 CCPA 1140, 174 USPQ 114 (1972).” *In re Ehrreich*, 590

F.2d 902, 909 (Emphasis original). Accordingly, it was incumbent on the Appellants to address the combination of Albazz and the conventionality of databases in order that a challenge to the rejection could be persuasive.

Instead, the Appellants have addressed only Albazz. Nowhere in the Briefs do the Appellants address the Examiner's taking of Official Notice that databases are well known and that it would have been obvious to incorporate a conventional database in Albazz to thereby arrive at the claimed system. All the arguments raised depend on whether one of ordinary skill in the art would have known to use a conventional database for contract generation and administration at the time of the invention and yet the conventionality of databases has not been addressed. For example, the Appellants argue in the Appeal Brief and the Reply Brief that the claims recite what the Appellants' deem to be "functional descriptive limitations" which the Appellants argue the Examiner has not shown Albazz to disclose. But what the Appellants deem to be "functional descriptive limitations" (*i.e.*, "report generating capability, the use of reports to track, manage, and administer contractual obligations, and the use of reports for business forecasting and planning" (App. Br. 13)) would have been considered to be the normal functions of a conventional database adapted for use in contract generation and administration (*see Albazz*) to one of ordinary skill in the art at the time of the invention. Without having given a position on the conventionality of databases and thus not addressed what the references would *collectively suggest* to one of ordinary skill in the art, the Appellants cannot be said to have provided an adequate challenge to the question of obviousness under §103 raised by the Examiner.

The Appellants have not addressed the combination of references *as a*

whole but simply improperly argued the merits of Albazz individually. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968). As a result, the Appellants' arguments are not persuasive as to error in the rejection of claims 1-11.

Claims 12-28

The Appellants argued claims 12-28; 29-42; 43-53; 54-61; 62-68; 69-75; and, 76 as seven separate groups (App. Br. 14-23 and Reply Br. 7-21). We select claims 12, 29, 43, 54, 62, and, 69, as the representative claims for the first six groups, respectively, and the remaining claims 13-28; 30-42; 44-53; 55-61; 63-68; and, 70-75 stand or fall with claims 12, 29, 43, 54, 62, and, 69, respectively. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Unlike claims 1-11, these claims are drawn to methods. However, the Appellants' position with respect to the rejection of these claims suffers for the same reasons. The Appellants have addressed only Albazz. Yet, the claims were not rejected over Albazz alone but over Albazz and that "databases are old and well known" (Answer 5). Nowhere do the Appellants address the Examiner's taking of Official Notice that databases are well known. We find the Appellants have not addressed the combination of references *as a whole* but simply improperly argued the merits of Albazz individually. As a result, the Appellants' arguments are not persuasive as to error in the rejection of claims 12-76.

CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1-76 under 35 U.S.C. §103(a) as being unpatentable

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over Albazz and Official Notice that "databases are old and well known"
(Answer 5).

DECISION

The decision of the Examiner to reject claims 1-76 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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